

U.S. Application No. 10/662,623  
AMENDMENT B AND REQUEST FOR A TELEPHONE INTERVIEW

ATTORNEY DOCKET NO.: 4032.001

**REMARKS**

Review and reconsideration of the Office Action dated September 27, 2005, is respectfully requested in view of the following amendments and the following remarks.

Claims 5, 6, 8, 10, and 11 have been amended by replacing the open transitional phrase "comprising" with the closed transitional phrase "consisting of".

No new matter has been added to the claims.

Applicant believes that the present set of claims is not obvious over the cited art. Applicant's position regarding the cited references can be found below.

In addition, Applicants is filing herewith a Request for a Telephone Interview with the Examiner. Applicant respectfully requests that the Examiner contact the undersigned for the telephone interview prior to the issued of any further action.

**Office Action:**

Turning to the Office Action, the paragraphing of the Examiner is adopted.

**Obviousness**

The Examiner rejects Claims 2-11 under 35 U.S.C. 103(a), as being obvious over U.S. Patent Application 2002/0157294A1 to Stanley in view of US Patent 6, 131,345 to Pelusio.

The position of the Examiner can be found on pages 2-7 of the Office Action.

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Applicant respectfully traverses.

Applicant notes that all the independent claims include the closed transitional phrase "consisting of". This terminology is interpreted to mean that any embodiment that does not contain exactly (no more or no less than) the elements recited in the claims is not considered to be encompassed by the claim.

Applicant reviewed the Stanley reference and notes that the main difference between the present invention and the Stanley reference is that the reference fails to teach that the graphic representation depict a window having grille and panels.

The Examiner cited the Pelusio reference to show a window façade that is attached to a garage door.

#### Regarding the Stanley Reference

Applicant reviewed the Stanley reference and notes that the reference teaches a magnetic pad having a decorative matter in one of its faces. The magnetic sheet is used on metallic surfaces, such as-- garage door. **The decorative matter includes alpha/numeric matters, graphic representations, or other ornament phrases.**

Nowhere in the Stanley reference can be found the teaching of having a graphic representation other than a festive occasion. (See Claim 2, paragraphs [0021], [0025], and [0026]).

Applicant notes that the main objective of the Stanley reference is to provide an over-all decorative identification of a festive occasion. **The decorations include designs for figures representing holidays festive, such as--figures flags for 4<sup>th</sup> of July, Happy-Birthday signs, etc.**

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Nowhere in the Stanley reference can be found the teaching of producing a garage door window facade.

The Examiner cited the Pelusio reference, to show a window facade for a garage door to simulate a built-in garage door window.

Applicant agrees with the Examiner that indeed the Pelusio reference shows a window façade for a garage door.

Please note that the Pelusio reference concerns with a window façades (architectural accents) that are design to be **permanently** attached to the garage door (bolts, adhesive, screws).

#### **Combining the references**

According to the Examiner, it would have been obvious to a person **skilled in the art** at the time the Stanley device was made, to form the magnetic pad with a graphic representation of a window.

Applicant respectfully reminds the Examiner that the motivation to modify the prior art must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention. Evidence of such motivation may **"flow from the prior art references themselves**, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved."

In the present case, the Stanley reference mentions graphic representations, but the reference does not teach or suggest having the graphic representation in the shape of a window.

Applicant notes that the Examiner has not demonstrated all the elements of obviousness and that, therefore, the applicant

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is deserving of a patent. For all of the elements to have been met, all of the following must be true: (1) all of the references that the Examiner is relying on must have been in the prior art (in a chronological sense), (2) all of the references must be either in the field of the inventor's endeavor or in a reasonably pertinent field, (3) the reference(s) must generally place the subject matter of the claimed invention in prior art, (4) a reason, suggestion or motivation for combining the teachings of the references to produce the claimed invention must be present in the prior art, and (5) the resulting combination or modification of the prior art would render the claimed invention obvious to a person having ordinary skill in the art.

The second element of the case requires that all the references be in one or more arts (technical fields) that are analogous to that of the claimed invention (MPEP 2141.01(a)). The Federal Circuit has stated that the references must be "reasonably pertinent to the particular problem with which the inventor is involved" and that "common sense" must be used to decide "in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor."

In the present case, the field of invention of the Pelusio reference is building construction. The field of Stanley invention is decorative displays. Applicant would like to point out to the Examiner that "festive decorations" (seasonal, short-term use, easily removable) are different from the "building construction" (long-lasting, permanent mounting required). Thus, a person of ordinary skill in the Stanley field of

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invention (festive decoration) would not look for a solution to the problem facing the present inventor by modifying the Stanley product to include the representation of a window façade. All the window façades of the prior art are designed to be permanently mounted on the wall or door (screw, bolts, or adhesive). The window facades of the prior art are permanently attached to the surface of the door. Nobody, prior to the present inventor would though of the idea of forming the magnetic pad of Stanley in the shape of a window façade.

Furthermore, Applicant notes that the Pelusio patent issued more than two years before the Stanley application. Thus, the teaching of Pelusio was already known in architectural accents technology at the time the festive pad of the Stanley reference was made. Thus, why if it would be so obvious to a person skilled in the art at the time the Stanley device was made to form the pad with a graphic representation of a window, did Stanley not considered the window shape?

The third element of the case requires that the references "teach or suggest all the claim limitations," that is, all the features of the claimed invention (MPEP 2143). In the words of the Federal Circuit, "the test for obviousness is not whether the features of one reference may be bodily incorporated into another reference . . . . Rather, we look to see whether combined teachings render the claimed subject matter obvious.

The fourth element requires that the prior art as a whole contain some implicit or explicit reason, suggestion or motivation for a person of ordinary skill (**having no knowledge of the claimed invention**) to combine or modify the references in

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the way proposed by the Examiner. Just because references can be combined or modified does not render the proposed combination obvious, unless the prior art also suggests the desirability of the combination (MPEP 2143.01). A reasonable expectation of success of the proposed combination or modification is also required (MPEP 2143.02). Potential sources for motivation to combine references include the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons having ordinary skill in the art.

In the present case, the Examiner is making the very human mistake of using impermissible hindsight (recognizing the advisability to combine the references only after the inventor has claimed the combination) as the motivation to combine the references.

The fifth element requires that the combination of teachings assembled by the Examiner appear to show or suggest that the claimed subject matter would have been obvious at the time the claimed invention was made to a person having ordinary skill in the art (not **today, but way back when you thought of it**). The claim as a whole must be considered because it is inappropriate for the Examiner to piece together an invention using the claim limitations as a guide.

Moreover, it is not the opinion of the inventor or the Examiner (who may be experts in the art), but that of the hypothetical "person of ordinary skill" who is presumed to be aware of all of the pertinent prior art and who has "the capability of understanding the scientific and engineering principles applicable to the pertinent art" that counts (MPEP

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2141.03). Sometimes non-obviousness can be established by showing that the inventor discovered the problem, because U.S. patent law permits patenting of inventions that address problems that are difficult to detect but easy

In the present case, the inventions of Stanley and Pelusio operate in essentially opposite ways. Pelusio is concern with structures that are **permanently attached** to the surface of the door. On the contrary, Stanley is directed to structures that easily removable from the surface of the door. Therefore, in addition, one of ordinary skill could have had no reasonable expectation of success in practicing the combination of Pelusio and Stanley.

Applicant believes that the Examiner is using Applicant's disclosure as a blueprint to reconstruct the claimed invention from isolated pieces of the prior art contravenes the statutory mandate of § 103, which requires judging obviousness at the point in time when the invention was made. *See Grain Processing Corp. v. American Maize-Prods. Co.*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988).

Applicant would like to point out to the Examiner that the present invention is designed to fill a need. Recently, laws passed, which prevent a person to buy windows for their garage door or buy a new garage door with windows. The window façade of the present invention provides the consumer with the option of having an easy to install and remove window façade that the consumer can legally install.

Claims 2 -4 are novel in view of their dependency with novel Claim 1.

**Regarding Claims 7 and 9**

Applicant notes that Claims 7 and 9 require that the grille and geometric panels are color coordinated to match the metallic surface. Nowhere in either of the references can be found the teaching that the window has to be color coordinated. Stanley does not have any motivation to color coordinate the decoration with the garage door, because the decoration contains the color of the specific festivities (red, blue, and white for 4<sup>th</sup> of July; green and red for Christmas, etc).

**Regarding Claim 10**

Applicant notes that the claim requires a sheet and a magnet attached to the sheet. **Neither of the cited references teach a magnet attached to the sheet.**

Thus, Claim 11 is novel and not obvious over the cited references.

In addition, Applicants would like to respectfully point out to the Examiner that the present invention provides the consumer with façade windows that serve a function at a lower cost. The present invention makes the home look better because they serve as a hardware type fixture that provides eye catching appeal that will improve the market ability and homeowner satisfaction.

Furthermore, the present invention does not violate the integrity or surface of the door since no drilling, cutting, or adhesive is needed for installation.

Furthermore, the present invention provides the consumer with architectural accent without having to obtain a local government permit to replace your garage door. The present invention fills a need for the consumer that does not require



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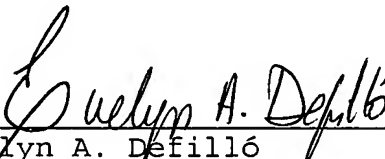
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tools and a handy man, this product is designed for anyone with hands, extremely easy installation. The present invention fills a specific need of a consumer to add a permanent focal point on their home not a seasonal display.

Accordingly, the withdrawal of the rejection is respectfully requested.

Favorable consideration and early issuance of the Notice of Allowance are respectfully requested. Should further issues remain prior to allowance, the Examiner is respectfully requested to contact the undersigned at the indicated telephone number.

Respectfully submitted,

  
Evelyn A. DeFillio  
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Date: **December 27, 2005**

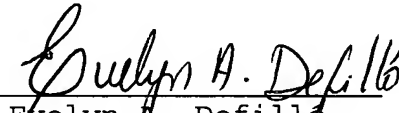
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**CERTIFICATE OF MAILING AND AUTHORIZATION TO CHARGE**

I hereby certify that the foregoing AMENDMENT B AND REQUEST FOR A TELEPHONE INTERVIEW for U.S. Application No. 10/662,623 filed September 15, 2003, were deposited in first class U.S. mail, postage prepaid, addressed to: Mail Stop AF, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on **December 27, 2005.**

The Commissioner is hereby authorized to charge any additional fees which may be required at any time during the prosecution of this application without specific authorization, or credit any overpayment, to Deposit Account No. 16-0877.

  
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Evelyn A. DeFillio